

REMARKS

Claims 1, 3-10, 13, 16-18, 20 and 36 are pending. The Examiner's reconsideration of the rejections in view of the amendments and remarks is respectfully requested.

Claims 1, 3-10, 13, 16-18, 20 and 36 have been rejected under 35 USC 101, as failing to be directed to a practical application and in addition for violating the doctrine of preemption.

Claims 1 and 36 claim, *inter alia*, “passing the parameters to an externalized inferencing component upon executing a trigger point in the program of instructions; evaluating, by the externalized inferencing component, the data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions, wherein the externalized inferencing component is in communication with the program of instructions, wherein the inference is a derivation of the knowledge; storing the knowledge derived by the inference with the data; and outputting the knowledge derived by the inference to trigger point of the program of instructions.”

Such an application of an externalized inferencing component evaluating parameters passed by a trigger point to perform an inference is believed to be a practical application of a method (embodied in a computer readable medium (see Claim 1) and a system for executing a program of instructions in communication with an externalized inference component (see Claim 36)). Consider that in *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981), the Court noted, “when [a claimed invention] is performing a function which the patent laws were designed to protect (e.g., transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of Section 101.” *Diehr*, 450 U.S. at 192. In Claims 1 and 36, the claimed a computer processes perform inferencing external to a program of instructions, passing

parameters by a trigger point for evaluation by an externalized inferencing component to perform the inferencing (external to the program of instruction). Thus, the claimed process is believed to be statutory as being limited to a practical application in the technological arts of computer programming.

Therefore, Claims 1 and 36 are believed to be directed towards statutory subject matter.

Turning now to the suggestion that the claims violated the doctrine of preemption: that is whether the claim would, in reality, preempt the use of a law of nature or abstract idea. While one may not patent a process that comprises every substantial practical application of an abstract idea, because such a patent in practical effect would be a patent on the abstract idea itself, the claims are clearly presented in terms of a computer readable medium (see Claim 1) and a system for executing a program of instructions in communication with an externalized inference component (see Claim 36). Accordingly, the claims are not directed to mere abstract ideas but include limitations that are both concrete and tangible. Consider the method step of “evaluating, by the externalized inferencing component, the data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions, wherein the externalized inferencing component is in communication with the program of instructions, wherein the inference is a derivation of the knowledge” (emphasis added), which comprises substantial limitations outside the realm of mere abstraction such as a mathematical formula without a practical application. While such a limitation may cover a board range of computer readable mediums and systems for executing a program of instructions, the claims clearly rise above the level of an abstract idea.

The Examiner’s reconsideration of the objection is respectfully requested.

Claims 1-33 have been rejected under 35 U.S.C. 102(a) as being anticipated by *IBM*, “Websphere Application Server Enterprise Services Business Rule Beans (BRBeans),” 2001 (hereinafter *IBM*). The Examiner stated essentially that *IBM* teaches or suggests all of the limitations of Claims 1-33.

Claim 1 is the independent claim.

Claim 1 claims, *inter alia*, “passing the parameters to an externalized inferencing component upon executing a trigger point in the program of instructions; evaluating, by the externalized inferencing component, the data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions, wherein the externalized inferencing component is in communication with the program of instructions, wherein the inference is a derivation of the knowledge; storing the knowledge derived by the inference with the data; and outputting the knowledge derived by the inference to trigger point of the program of instructions.”

IBM teaches externalized business rules (see page 32). *IBM* does not teach, “evaluating, by the externalized inferencing component, the data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions... storing the knowledge derived by the inference with the data,” essentially as claimed in Claim 1. The externalized business rules of *IBM* adhere to externalization techniques, wherein logic and data are implemented for making classifications, for example, for checking whether a truck weight entered is valid (see *IBM*, page 33, point 1). The externalized business rules of *IBM* are not analogous to externalized inferencing components as claimed in Claim 1. For example, one could write an externalized business rule as described in *IBM*, however, *IBM* does not teach how

to cause the externalized business rule to do inferencing. The externalized business rules of *IBM* are used for making classifications and do not include inference components - for example, the derivation rule (page 3 of *IBM*) simply returns a “value.” *IBM* does not teach that the value is new knowledge. The claimed inferencing derives new knowledge from rules and knowledge (data and parameters). *IBM* simply does not teach inferencing. More particularly, the RuleImplementor does not evaluate “data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions” essentially as claimed in Claim 1.

Turning to the operation of *IBM*’s IF/THEN statement; the IF/THEN statement of *IBM* is a conditional statement used in only classification and lacks inherent inferencing capabilities. The IF/THEN statement, on its own, lacks the complexity for deriving knowledge. The IF/THEN statement is merely a logical argument that cannot be considered an inference as it, by itself, does not derive knowledge.

Further, *IBM* fails to teach that an output of the RuleImplementor may be added to data; *IBM* does not teach “storing the knowledge derived by the inference with the data” as claimed in Claim 1.

For at least the foregoing reasons, *IBM* fails to teach all the limitations of Claims 1.

Claims 3-10, 13, 16-18 and 20 depend from Claim 1. The dependent claims are believed to be allowable for at least the reasons given for Claim 1. Claims 2, 11-12, 14-15, 19 and 21-33 have been cancelled. The Examiner’s reconsideration of the rejection is respectfully requested.

Claim 36 is believed to be allowable for at least the reasons given for Claim 1.

For the forgoing reasons, the application, including Claims 1, 3-10, 13, 16-18, 20 and 36, is believed to be in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

Respectfully submitted,

Dated: February 19, 2008

/Nathaniel T. Wallace/
Nathaniel T. Wallace
Reg. No. 48,909
Attorney for Applicants

F. CHAU & ASSOCIATES, LLC
130 Woodbury Road
Woodbury, New York 11797
TEL: (516) 692-8888
FAX: (516) 692-8889